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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/782,500

02/19/2004

Kyusun Chang

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5647

50170

7590

03/13/2008

IBM CORP. (WIP)

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EXAMINER

WOOD, WILLIAM H

ART UNIT

PAPER NUMBER

2193

MAIL DATE

DELIVERY MODE

03/13/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/782,500	<b>Applicant(s)</b> CHANG ET AL.	
	<b>Examiner</b> William H. Wood	<b>Art Unit</b> 2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 12, 13, 16, 19, 21, 22, 27, 29 and 30 is/are rejected.
- 7) ☒ Claim(s) 2, 5-11, 14, 15, 17, 18, 20, 23-26, 28 and 31-34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/19/04</u> .   | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

Claims 1-34 are pending and have been examined.

***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 19 February 2004 has been considered by the examiner.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Independent claims 19 and 27 encompass "computer-usable mediums" (Specification: page 3, line 3). As such computer-usable mediums include non-statutory electromagnetic signals, the claims are rejected. The dependent claims do not correct the problem. Appropriate correction required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 3-4; 12-13 and 16; 19 and 21-22; 27 and 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by **Cheng** et al. (USPN 6,151,643).

Claim 1

**Cheng** discloses a method of transforming (*column 2, lines 62-65*) an application, said method comprising:

assessing readiness for transformation, based on a plurality of desirable application s attributes (*column 7, lines 54-57*);

mapping at least some of said desirable application attributes to at least some kinds of help (*column 7, lines 62-64*);

generating a proposal for transformation, based on results of said assessing and said mapping; and outputting said proposal (*column 7, lines 62-64*).

Claim 3

**Cheng** discloses the method of Claim 1, wherein said assessing and said mapping may be performed for a plurality of transformation stages (*figure 2*).

Claim 4

**Cheng** discloses the method of Claim 1, wherein said assessing readiness for transformation further comprises:

providing assessment questions associated with said desirable application attributes; and receiving input in response to said questions; wherein said questions are designed to draw attention to transformation issues (*figures 4 and 10*).

Claims 12-13 and 16

The limitations of claims 12-13 and 16 correspond to claims 1 and 3-4 and as such are rejected in a corresponding manner.

Claims 19 and 21-22

The limitations of claims 19 and 21-22 correspond to claims 1 and 3-4 and as such are rejected in a corresponding manner.

Claims 27 and 29-30

The limitations of claims 27 and 29-30 correspond to claims 1 and 3-4 and as such are rejected in a corresponding manner.

***Allowable Subject Matter***

Claims 2 and 5-11; 14-15 and 17-18; 20 and 23-26; 28 and 31-34 are objected to as being dependent upon a rejected base claim, but would be

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allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Correspondence Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Wood whose telephone number is (571)-272-3736. The examiner can normally be reached 10:00am - 4:00pm Tuesday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lewis A. Bullock Jr. can be reached on (571)-272-3759. The fax phone numbers for the organization where this application or proceeding is assigned are (571)273-8300 for regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR systems, see <http://pair-direct.uspto.gov>. For questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

/William H. Wood/  
William H. Wood  
Primary Examiner, Art Unit 2193  
March 13, 2008